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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,223	04/24/2000	John E. Tafoya	MCS-018-99	8345

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EXAMINER

ANDERSON, LARRY O

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,223

Applicant(s)

TAFOYA ET AL.

Examiner

Larry O Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 21-23, 26-37 and 39-53 is/are rejected.
- 7) ☒ Claim(s) 17-20, 24, 25 and 38 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: page 6, line 2 contains the phrase “is can be” which should be replaced with “can be”.

Appropriate correction is required.

Claim Objections

2. Claim 42 is objected to because of the following informalities: it contains the word ‘via’ (line 1), which should be removed to promote clear understanding of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10, 12-16, 21-22, 26-36, 37, 39-43, and 45-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Novell Groupwise 5.5 as shown by “GroupWise User's Guide for Windows 95/98/NT” (hereinafter Groupwise).
3. Regarding claims 1, 10, 32, and 48, Groupwise teaches automatically extracting contact information from a data store by scanning electronic files/messages (see page 124, under heading “Using Frequent Contacts”; where Groupwise teaches capturing addresses and contact

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information from sent and received email messages); maintaining/populating a list of at least one contact entry derived from the information extracted (see page 124, under heading “Using Frequent Contacts to Address Items”; where Groupwise displays an example list of contacts derived from the capturing of data); tracking contact information associated with the entry (see page 126, step 4; where Groupwise discloses tracking the time from the last use of the contact’s information); and resolving contact entries in real time by providing the most probable specific contact entries from the maintained list (see pages 123 and 125, in the “Tips” shaded box; where Groupwise discloses using “Name Completion”, which looks up the name being typed in real time from the maintained list of contact entries).

4. Regarding claims 2, 3, and 27, Groupwise teaches a data store including sent and received e-mail, which are electronic documents and scanned upon entering the data store (see page 124, under heading “Using Frequent Contacts”; where Groupwise teaches capturing addresses and contact information from sent and received email messages).

5. Regarding claim 4, Groupwise teaches entries of the maintained list being weighted (see image on page 124; where Groupwise discloses the maintained list being weighted by alphabetical order, the entries closest to the front of the alphabet are displayed first, and those near the end are displayed at the end).

6. Regarding claims 5 and 37, Groupwise teaches the weight of an entry being updated dynamically based on the number of times the entry has been used (see pages 126 and 127, under heading “Using Predefined Filters for the Frequent Contacts Address Book”; where Groupwise discloses the number of times a contact has been referenced or used determines if it is included in the results).

7. Regarding claim 6-8, Groupwise teaches the weight of an entry dynamically updated based on the time since an email using/matching the contact data of the entry was sent/received/added to the data store (see page 126, steps 2-4; where Groupwise discloses eliminating contact entries and their corresponding weight when their contact info has not been referenced by a sent or received message).
8. Regarding claims 9, 16, and 28, Groupwise teaches the weight of an entry dynamically updated as new information enters the data store (see page 124, under heading “Using Frequent Contacts”; where Groupwise teaches capturing addresses and contact information from new received email messages).
9. Regarding claim 12, Groupwise teaches automatically resolving contact entries by providing the entry having the greatest weight where one entry matches an input (see pages 123 and 125, in the “Tips” shaded box; where Groupwise discloses using “Name Completion”, which looks up the name being typed in real time from the maintained list of contact entries, and provides the closest weighted match).
10. Regarding claim 13, 14, 15, 22, 39, 40, 46, and 52, Groupwise teaches constraining/changing the size of the list to improve performance of automatically resolving contact entries and using or excluding certain existing contact databases/electronic files (see page 110, under heading “Defining Name Completion Search Order”; where Groupwise discloses allowing users to add or remove address books to be included in the “Name Completion” search feature). With respect to claim 15, Groupwise teaches a user disabling the list (see page 110, Step 4).

11. Regarding claims 21 and 41, Groupwise teaches adding new entries to the list after they are first used and their new information enters the data store (see page 124, under “Using Frequent Contacts”; where Groupwise discloses adding entries to the list in the first paragraph, after they have been used).
12. Regarding claims 26, 45, and 51, Groupwise teaches an automatically resolved contact entry based on a full or partial match selectable by a user via a user interface (see page 111, under “Tips” shaded box, 3rd bulleted item; where Groupwise discloses a dialog box allowing a user to choose a resolved contact entry).
13. Regarding claim 29, Groupwise teaches particular items in the data store being excluded from tracking (see pages 134 and 135, under “Viewing Groups, Organizations, or Resources in the Address Book”; where Groupwise discloses applying filters so that items in the data store are excluded and not displayed).
14. Regarding claims 30, 47, and 53, Groupwise teaches excluding specific e-mail addresses (see pages 134 and 135, under “Viewing Groups, Organizations, or Resources in the Address Book”; where Groupwise discloses applying filters so that items in the data store are excluded and not displayed; and see pages 149-154; where Groupwise discloses specific filters including e-mail addresses are specified to exclude).
15. Regarding claims 31, 34-36, and 50, Groupwise teaches an e-mail address and a friendly name (see page 130, the top Figure, which discloses a display name as well as an e-mail address); a number of times that the entry has been used (see page 124, under the heading “Using Frequent Contacts”; where Groupwise discloses in the first paragraph the number of times an entry has been used); a date the e-mail was last sent to (see page 154, where Groupwise discloses

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the contact filter field “Delivered”, which contains the date that a message was delivered on; and page 156, where Groupwise discusses the contact filter field “To”, which combined with “Delivered” can be used for the date the e-mail was last sent to); a date the email address was last received from (see page 154, where Groupwise discloses the contact filter field “Delivered”, which contains the date that a message was delivered on; and the contact filter field “From”, which combined with “Delivered” can be used for the date the e-mail was last sent from); and a weight (see image on page 124; where Groupwise discloses the maintained list being weighted by alphabetical order, the entries closest to the front of the alphabet are displayed first, and those near the end are displayed at the end).

16. Regarding claims 33 and 49, Groupwise teaches sent and received e-mail (see page 124, under heading “Using Frequent Contacts”; where Groupwise teaches capturing addresses and contact information from sent and received email messages); email addresses and contacts that exist within previous systems (see page 133, under “Sharing an Address Book with Another User”; where Groupwise discusses sharing another user’s address book, which has previously been used on a previous system by a different user, including their email addresses and contacts in their address book); email stores located on public servers (see page 111, where Groupwise discloses the use of LDAP servers, and retrieval of contact information from those public servers); current and previous contact databases (see pages 129-131, where Groupwise discloses using a current contact database; and page 133, under “Sharing an Address Book with Another User”; where Groupwise discusses sharing another user’s address book, which has previously been used on a previous system by a different user, including their email addresses and contacts in their address book); and data embedded within application electronic files (see page 124,

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under heading "Using Frequent Contacts"; where Groupwise teaches capturing addresses and contact information from sent and received email messages, created by e-mail clients).

17. Regarding claim 42, Groupwise teaches a list capable of being browsed via a user interface (see Figure on page 124).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 11, 23, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novell Groupwise 5.5 as shown by "GroupWise User's Guide for Windows 95/98/NT" (hereinafter Groupwise) in view of U.S. Patent No. 5,923,848 (Goodhand et al., hereinafter Goodhand).

20. Regarding claim 11, Groupwise teaches all the limitations of claim 11, except for providing a most recently used match to an input. Goodhand teaches automatically resolving contact entries by providing a most recently used match to an input (see column 18, lines 36-48; where Goodhand teaches a most recently used match in the context menu based on an input). It would have been obvious to one of ordinary skill in the art, having the teachings of Groupwise and Goodhand before him at the time the invention was made, to modify the e-mail resolution system taught by Groupwise to include providing a most recently used match, so that the match

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can correspond to the most recently intended recipient (see column 18, 45-46) as taught by Goodhand.

21. Regarding claim 23, Groupwise teaches all the limitations of claim 23, except for storing the list in random access memory and caching the list in a non-volatile storage medium.

Goodhand teaches storing the list in random access memory (see column 18, lines 23-26; where Goodhand discloses storing the list in system memory or random access memory) and caching the list in a non-volatile storage medium (see column 19, lines 26-31; where Goodhand teaches the list being part of the user's profile, which is stored in memory storage devices). It would have been obvious to one of ordinary skill in the art, having the teachings of Groupwise and Goodhand before him at the time the invention was made, to modify the e-mail resolution system taught by Groupwise to include storing the list in RAM and caching it in non-volatile storage, so that the system can know if the name has been resolved in the past (see column 18, 25-27) as taught by Goodhand.

22. Regarding claims 43 and 44, Groupwise teaches all the limitations of claims 43 and 44, except entries from the list being added to an address book via a user interface. Good hand teaches entries from the list being added to an address book via a user interface (see column 18, lines 2-4; where Goodhand discloses adding the name appearing in the list or context menu to the address book). It would have been obvious to one of ordinary skill in the art, having the teachings of Groupwise and Goodhand before him at the time the invention was made, to modify the e-mail resolution system taught by Groupwise to include adding entries from the list to an address book via a user interface, so that addresses in the list can be stored (see column 18, lines 4-7) as taught by Goodhand.

Allowable Subject Matter

23. Claims 17-20, 24-25, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

24. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach or fairly suggest the combination of limitations that the applicant has claimed in claims 17-20, 24-25, and 38. The prior art fails to teach removing entries from the list and replacing them with new entries when the list is full; adding replacement entries that are at least equal to the weights; not adding entries if entries in the list have higher weights than the new entry; choosing an entry at random to be replaced when multiple entries have the same lowest weight; removing entries from the list when matching entries are added to a contact database; and not adding entries to a list if already stored in a contact database with indicated features corresponding to what the inventor has claimed.

Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar e-mail resolution systems and contact arrangements

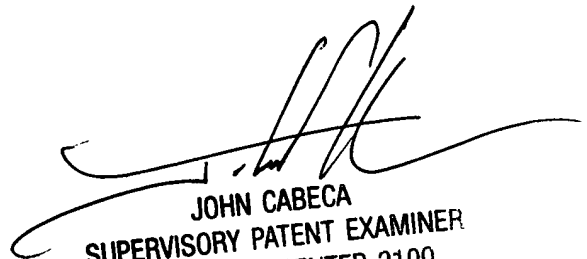
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry O Anderson whose telephone number is 703-305-7212. The examiner can normally be reached on M-TR 6:55-4:25 1st Fri. Off, 2nd Fri. 7:20-3:50.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-308-3116. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

loa
October 10, 2002



JOHN CABECA
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